REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

In the Amendment applicants amended claims 1 and 18. The feature of the orientation of the intake nozzle 20 defined in claim 1 in the longitudinal direction of the housing 10 is disclosed in Figures 6 and 7.

Applicant has also added claims 19-25. The feature of claim 19 is disclosed in Figures 4-7. The features of claims 20, 21, 22, 23 and 24 are shown in Figures 4-6. Moreover, the feature of claim 24 is also disclosed on page 6, lines 11-15 of the specification. The feature of claim 25 is disclosed in Figure 6 and on page 6, lines 10-15 and 25-28 of the specification.

It is respectfully submitted that the new features of the present invention as defined in claim 1 are not disclosed in the prior art applied by the Examiner.

The U.S. patent to Modrey (US 2,776,385) discloses an electric power unit including an electric motor which is enclosed in a housing (13). For ventilating all parts of the motor, a ventilation channel consisting of two parts (14,

15) is arranged in the housing (13). To connect the two parts (14, 15) with the exterior of the electric power unit an inlet duct (19) and an exhaust duct (20) are provided in a hose (16), and the hose is connected to the housing (13) through a connector (30, 31) with cones (40, 41) (see Modrey, figure 9 and column 2, line 55 to column 3, line 36). A junction between the housing (13) and the hose (16) is arranged diagonally in respect to a longitudinal direction of the housing (13) as can be seen in figure 1 of Modrey. One part (14) of the ventilation channel represents the corresponding means to the inlet duct (19) and the other part (15) corresponds to the exhaust duct (20). The parts (14, 15) of the ventilation channel merge with each other after a passage of the motor. Therefore, the parts (14, 15) represent input and output means or ducts of only one ventilation channel, which is integrally formed in the same housing (13) as the motor (see Modrey, figure 1 and col. 2, lines 55 to 59).

In contrast, claim 1 in the present application defines an electric power tool, having an electric motor located in a housing (10), and having a cooling device (16, 18, 20, 30, 32), wherein the cooling device (16, 18, 20, 30, 32) comprises at least one intake nozzle (20) extending in a longitudinal direction (42) of the housing (10), wherein said at least one intake nozzle (20) is mounted in an outer wall of the housing (10). The cooling device (16, 18, 20, 30, 3.2) further comprises a cooling conduit (30) which is located in direct proximity to the at least one intake nozzle (20) and is separated from the housing (10) in a direction

which is transverse to said longitudinal direction (42) by means of an additional casing (38), located between the cooling conduit (30) and the housing (10) in the transverse direction, wherein said cooling conduit (30) directly abuts said at least one intake nozzle (20) and is closed off in direct proximity to said at least one intake nozzle (20) from an interior of the housing (10), wherein cooling air reaches the cooling conduit (30) directly and unhindered in an operating mode.

The patent to Modrey completely lacks the feature, that an intake nozzle or the junction of the hose (16) with the housing (13), respectively, extends in a longitudinal direction of the housing (13) . Moreover the patent to Modrey does not disclose that the ventilation channel is separated from the housing (13) by means of an additional casing.

It is therefore believed to be clear that these new features of the present invention which are defined in claim 1 are not disclosed in the U.S. patent to Modrey.

The original claims were rejected over this reference as being anticipated. In connection with this, it is believed to be advisable to cite the decision in re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Modrey does not disclose each and every element of the electric power unit of the present invention as now defined in claim 1.

Therefore, it is respectfully submitted that the anticipation rejection of claim 1 should be considered as not tenable and should be withdrawn and claim 1.

The present invention can also be considered as obvious from the patent to Modrey for the above-presented reasons, and also because of the following. The patent to Modrey discloses an electric power unit with a housing (13), wherein the latter is connected to a hose (16) by means of a connector (30, 31) which has cones (40, 41) for connecting an inlet duct (19) and an exhaust duct (20) to an input duct (14) and an exhaust duct (15) of a ventilation channel, which ventilates the interior of a housing (13). The junction of the hose (16) to the housing (13) is arranged diagonally in respect of a longitudinal direction of the housing (13) . Furthermore, the ventilation channel is integrally formed with the housing (13) (see Modrey, figure 1 and 9, as well as column 2, lines 55 to column 3, line 36).

The inventive idea disclosed in the present application is to provide an electric power tool with a cooling device (16, 18, 20, 30, 32), wherein the cooling device (16, 18, 20, 30, 32) comprises at least one intake nozzle (20) extending in a longitudinal direction (42) of the housing (10). Moreover, the cooling device (16, 18, 20, 30, 32) further comprises a cooling conduit (30) which is located in direct proximity to the at least one intake nozzle (20) and is separated from the housing (10) in a direction which is transverse to said longitudinal direction (42) by means of an additional casing (38).

Due to the arrangement of the intake nozzle (20) as extension in the longitudinal direction (42) of the housing (10) , it is practically precluded that the intake nozzle (20) will be covered by mistake when the user is working with the electric power tool (see patent application, page 3, lines 5 to 8) . Therefore, the mentioned disadvantages of the prior art, specifically, a covering of air inlets by a user's hand and a loose of stability by means of longer lateral air inlets can be eliminated (as explained in the present application on page 1, lines 21 to 31).

The separation of the cooling conduit (30) from the housing (10) by means of an additional casing (38) has the advantage that the cooling conduit (30) can easily be integrated in all kind of power tools. In the industry of today the modular concept is widely spread and through such a construction as

defined in the present invention a broad field of use is available. Therefore, time and money can be saved in the development by this construction.

The patent to Modrey teaches no motivation which would have led someone skilled in the art to the inventive construction of the device of the patent application. Modrey does not disclose air inlet openings in the housing (13) which can be covered by a user's hand. Rather, the connection cones (40, 41) of the inlet duct (19) and the exhaust duct (20) are *per se* covered by the hose (16) or the ducts (19, 20) therewith. The inlet openings (26, 27), which are in contact with the exterior of the electric power unit and are at risk to be covered, are arranged at a point of the hose (16) which is well spaced from the motor housing (see Modrey, column 3, lines 8 to 12) . As a result, a covering of the air inlet openings (26, 27) by a user's hand due to a working process with the housing (13) is not possible. Thus, there is no need to arrange inlet openings for cooling air which extend in a longitudinal direction of the housing (13) . Moreover, this arrangement cannot be realized because the proper place for an arrangement in a longitudinal direction of the housing (13) is in conflict with first, the arrangement of a handle of the electric power unit and second, with the bearing position of a shaft (12) and therefore, of the motor (see Modrey, figure 1 and column 2, lines 49 to 55).

Furthermore, the patent to Modrey discloses no additional casing, by which the ventilation channel is separated from the housing (13). One part (14) of the ventilation channel adjoins the housing (13) directly, the other part (15) is led through a sub-part of the housing (13) to cool a rotor (11) which is mounted in the sub-part. This sub-part is no additional casing like it is intended in the present claim 1 of the patent application, where the additional casing (38) encircles the cooling conduit (30) to direct the cooling air from the intake nozzle (20) to a motor housing (26). Due to this encasement no exchange of air between the air in the cooling conduit (30) and the air in the exterior of the cooling conduit (30) or the interior of the housing (10) , respectively, is possible. Rather, the sub-part of the Modrey reference provides a bearing for the rotor (11) . Moreover, the sub-part is not located between the ventilation channel and the housing (13), because as stated above, the ventilation channel abuts the housing (13).

In addition, in this reference no encouragement is given to integrate an additional casing which separates the ventilation channel from the housing (13). The realization of an advantageous flexible assembly, which is molded beforehand and which consists of a cooling conduit and an additional casing, and which further can be used in various power tools, is not necessary for the device of the patent to Modrey, because the electric power unit is intended to be used in a flexible way with various power tools of its own volition

(see Modrey, column 1, lines 20 to 26). A reconstruction of the electric power unit is not necessary for its advantageous use and an integration of a feature which does not improve the usability of a device is a waste of time, costs and components and would be contradictory towards the guidelines of mechanical engineering.

It is therefore believed to be clear that , a person skilled in the art could not find any hints which would have led him to the arrangement of the air intake openings in a longitudinal direction of the housing (13) and to a separation of the ventilation channel from the housing (13) by means of an additional casing.

As explained herein above, the present invention provides for the highly advantageous results. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushma and Takahashi (174 USPQ 38), as follows:

> Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

Also, as explained herein above the present invention can not be considered as obvious simply from the reading of the Modrey reference. In order to arrive at the present invention from the reference, the reference has to be fundamentally modified by including into it the new features which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

> Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

It is therefore believed to be clear that claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims define additional features of the present invention, which in combination of the features of claim 1 also clearly and patentably distinguish the present invention from the prior art.

Reconsideration and allowance of the present application with all the claims currently on file is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

Michael J. Striker
Attorney for Applicant
Reg. No. 27233